

### **REMARKS**

These remarks are submitted in response to the Final Office Action dated April 13, 2010 (hereinafter the "Office Action"). At the time of the Office Action, claims 1-20 and 22 were pending. Claims 14-20 were rejected under 35 U.S.C. § 101. Claims 1-20 and 22 were rejected under 35 U.S.C. §103.

Claim 14 has been amended, and new claims 23 and 24 have been added. New claims 23 and 24 are supported by the specification and drawings (see, for example, paragraph [0113] of the published application). Therefore, no new matter has been added.

The Applicant would like to thank Examiner Chang for conducting a telephone conference on June 1, 2010, to discuss the various rejections and claim amendments. Applicant's position as articulated during the interview is set forth below.

#### **I. Claim Rejections Under 35 U.S.C. §101**

The Examiner rejected claims 14-20 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. The specification has been amended (see paragraph [0158] of the published application) to delete the references to "infrared, transport, propagate, and paper," as required by the Examiner. Also, claim 14 has been amended to recite a non-transitory, computer-readable storage medium. Accordingly, reconsideration and withdrawal of the rejection under § 101 are respectfully requested.

#### **II. Claim Rejections Under 35 USC §103**

The Examiner rejected claims 1-19 and 22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0128356 to Bernstein et al. (hereinafter "Bernstein"), in view of U.S. Patent Application Publication No. 2003/0229670 to Beyda (hereinafter "Beyda"), and U.S. Patent No. 7,406,501 to Szeto et al. (hereinafter "Szeto") .

The Examiner rejected claim 20 under 35 U.S.C. § 103(a) as being unpatentable over Bernstein in view of Beyda and Szeto, and further in view of U.S. Patent Application Publication No. 2002/0065894 to Dalal et al. (hereinafter "Dalal").

For the following reasons, these rejections are respectfully traversed.

**III. Response**

The traversal arguments set forth in the previous responses filed on November 14, 2008, August 26, 2009, and December 30, 2009, are still apropos and are herein incorporated by reference.

More specifically, claim 1 recites, *inter alia*, "determining, with an instant messaging client and utilizing a processor that is executing the instant messaging client, an Internet presence of a contact identified in an email message in response to displaying the email message to a user, wherein the determining comprises comparing an email address of the contact identified to an address book database and retrieving an instant messaging address of the contact identified from the address book database, and then using the retrieved instant messaging address to determine that the contact is present at the time that the email message is displayed to the user." Bernstein, whether taken alone or together with Beyda, clearly fails to teach or suggest such a determining of the internet presence of a contact identified in an email message.

While the Examiner relies on Szeto to allegedly disclose retrieving an instant messaging address of the contact identified from address book databases, and then using the retrieved instant messaging address to determine that the contact is present, Szeto is not prior art with respect to the present application. More specifically, on its face, the Szeto patent's earliest possible effective filing date is March 24, 2003, based on the Provisional Application No. 60/457,479. On the other hand, the present application is a Continuation-in-part of Application No. 10/326,479, filed on December 19, 2002, which is prior to the March 24, 2003 date of Szeto. Note that the parent Application No. 10/326,479 provides support for the feature relied on by the Examiner in applying Szeto (i.e., "determining comprises comparing an email address of the contact identified to an address book database and retrieving an instant messaging address of the contact identified from the address book database, and then using the retrieved instant messaging address to determine that the contact is present"). For example, see paragraphs [0076] and [0105] of the corresponding published Application No. 2004/0054737 of the parent Application No. 10/326,479.

Claims 9, 10, and 14 also clearly patentably distinguish over any reasonable interpretation of the cited references. For example, claim 9 recites "means for determining, with an instant messaging client and utilizing a processor that is executing the instant messaging client, an Internet presence of a contact identified in an email message in response to displaying the email message to a user, wherein the means for determining compares an email address of the contact identified to an address book database and retrieves an instant messaging address of the contact identified from the address book database, and then uses the retrieved instant messaging address to determine that the contact is present at the time that the email message is displayed to the user." Claim 10 recites "presence logic of an instant messaging client and utilizing the processor that is executing the instant messaging client, configured to determine an Internet presence of a contact identified in an email message in response to displaying the email message to a user, wherein the presence logic compares an email address of the contact identified to an address book database and retrieves an instant messaging address of the contact identified from the address book database, and then uses the retrieved instant messaging address to determine that the contact is present at the time that the email message is displayed to the user." The Examiner acknowledges that Bernstein and Beyda fail to disclose retrieving an instant messaging address of the contact identified from address book databases, and then using the retrieved instant messaging address to determine that the contact is present. Moreover, as noted above, Szeto is not prior art with respect to the present application, such that the obviousness rejection is improper.

Claim 14 recites, *inter alia*, a non-transitory, computer-readable storage medium being embedded with computer instructions for causing a computing device to:

instruct a programmable device to determine, at an instant messaging client, an Internet presence of a contact from an email message in response to displaying the email message to a user, wherein the determining comprises comparing an email address of the contact to an address book database and retrieving an instant messaging address of the contact from the address book database, and then using the retrieved instant messaging address to determine that the contact is present at the time that the email message is displayed to the user. Again, as acknowledged by the Examiner, both Bernstein and

Beyda are deficient, and Szeto is not prior art with respect to the present application. Thus, claim 14 is likewise patentable over the cited references.

The dependent claims are patentable in view of the arguments set forth above with respect to the corresponding independent claims, as well as based on the recitations set forth therein.

Moreover, new claims 23 and 24 have been added and recite that the multiple instant messaging addresses of the contact are stored in order of priority in the address book database, and that the order of priority is based on the user arranging each instant messaging address in order of the user's preference, respectively. These features are missing in the cited references.

### **CONCLUSION**

The application is now in full condition for allowance. The Examiner is invited to call the undersigned representative if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion. Please charge any deficiencies or credit any overpayment to Deposit Account No. 50-0951.

Respectfully submitted,

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